

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

WHAM-O, INC.,

Plaintiff,

v.

SLB TOYS USA, INC.,

Defendant.

No. C 06-04551 JSW

**ORDER GRANTING MOTION TO
TRANSFER**

INTRODUCTION

This matter comes before the Court upon consideration of the motion to transfer venue filed by SLB Toys USA, Inc (“SLB”). Having considered the parties’ pleadings, relevant legal authority and having had the benefit of oral argument, the Court HEREBY GRANTS SLB’s motion.

BACKGROUND

On March 1, 2006, SLB filed an action in the Central District of California against Wham-O, Inc. (“Wham-O”), Cornerstone Overseas Investments Ltd., Charterhouse Group, Inc., and Traxi, LLC (“the Central District action”). In its complaint in the Central District action, SLB asserted causes of action for trademark infringement, trade dress infringement, common law trademark infringement, breach of confidential and fiduciary relationship, and unfair competition. With respect to the trademark claims, SLB asserted that Wham-O and the other defendants infringed its trademark and tradedress rights with respect to SLB’s “*Banzai Falls*”

1 line of water slide products. (*See, SLB Toys USA, Inc. v. Wham-O, Inc.*, CV06-1382 (RSWL),
2 Complaint.)¹

3 Wham-O asserted counterclaims against SLB in the Central District action and
4 contended that SLB infringed Wham-O's color marks and tradedress pertaining to Wham-O's
5 "Slip 'N Slide" water slide product line. (Weingarten Decl., Ex. B (Answer and Counterclaim at
6 pp. 6-14).)

7 On July 26, 2006, Wham-O filed the complaint in this action, alleging that SLB has
8 infringed and diluted Wham-O's "Wave Rider" mark. (*Wham-O, Inc. v. SLB Toys USA, Inc.*,
9 06-4551-JSW, Complaint.) The "Wave Rider" is part of the "Slip 'N Slide" product line.
10 (Wham-O Complaint, Ex. 2.) It is undisputed that SLB's "Wave Rider" product is not a water
11 slide.

12 On August 16, 2006, SLB moved to transfer this action to the Central District of
13 California.

14 ANALYSIS

15 "For the convenience of parties and witnesses, in the interest of justice, a district court
16 may transfer any civil action to any other district or division where it might have been brought."
17 28 U.S.C. § 1404(a). As the moving party, SLB bears the burden of showing that the
18 inconvenience of litigating in this forum favors transfer. *See E. & J. Gallo Winery v. F. &*
19 *P.S.p.A.*, 899 F. Supp. 465, 466 (E.D. Cal. 1994) (noting that to meet this burden requires
20 production of affidavits or declarations identifying key witnesses and anticipated testimony).

21 In order for a district court to transfer an action under section 1404, it must make the
22 following two findings: (1) that the transferee court is one where the action "might have been
23 brought;" and (2) that the convenience of the parties and witnesses and the interest of justice
24 favor transfer. *Hatch v. Reliance Ins. Co.*, 758 F.2d 409, 414 (9th Cir. 1985). There is no
25 dispute in this case that SLB could have brought this action in the Central District of California.
26 Accordingly, SLB has met its burden on this prong.

27
28 ¹ Attached as Exhibit A to the Declaration of Alex M. Weingarten in Support of
Defendant SLB Toys USA, Inc.'s Motion to Transfer Venue to Central District of California
("Weingarten Decl.").

1 To determine whether SLB has met its burden on the second prong, the Court considers
2 the following factors: plaintiff's choice of forum; convenience of the parties; convenience of the
3 witnesses; access to compulsory process of third party witnesses; ease of access to sources of
4 proof; local interest in the controversy; familiarity of each forum with the applicable law; and
5 relative court congestion in each forum. *Gulf Oil Co. v. Gilbert*, 330 U.S. 501, 508-09 (1947);
6 *Decker Coal Co. v. Commonwealth Edison Co.*, 805 F.2d 834, 843 (9th Cir. 1986). It is within
7 the Court's discretion to determine whether the convenience of the parties, convenience of the
8 witnesses, and the interests of justice would be served by transfer. *E. & J. Gallo*, 899 F. Supp.
9 2d at 466. The Court also considers the fact that SLB filed the Central District action first. *See*
10 *Alltrade, Inc. v. Uniweld Products, Inc.*, 946 F.2d 622, 625 (9th Cir. 1991) (discussing "first-to-
11 file" rule).

12 **1. The Plaintiff's Choice of Forum.**

13 A court should give the plaintiff's choice of forum deference unless the defendant can
14 show that the other factors of convenience clearly outweigh that choice. *Decker Coal Co.*, 805
15 F.2d at 843. In opposing the motion to transfer, Wham-O contends that the Court should afford
16 great deference to Wham-O's choice to file in its home forum. Wham-O acknowledges that the
17 Central District action was filed earlier than this case but argues that SLB's assertions regarding
18 the relationship between this case and the Central District action are misleading because
19 different marks are at issue and because the allegedly infringing products are not water slides.
20 As noted, the "*Wave Rider*" mark is a mark falling within Wham-O's *Slip 'N Slide* product line,
21 the product line at issue in the Central District action. Because of the potential overlap between
22 the two actions and because SLB filed the Central District action first, the Court gives less
23 weight to Wham-O's choice of forum.

24 **2. The Convenience of the Parties.**

25 In addition to considering the plaintiff's choice of forum, when deciding a motion to
26 transfer a court considers the relative convenience of the competing forums to all the parties
27 involved in the lawsuit. *Gulf Oil Co.*, 330 U.S. at 508. SLB argues that it would be more
28 convenient for it to litigate this matter in the Central District, its home forum, while Wham-O

1 argues that it would be more convenient to litigate the case in the Northern District, its home
2 forum. The record establishes that party witnesses are located in both the Central District and
3 the Northern District. Wham-O contends that some of its employees are located in
4 Massachusetts, Texas and Missouri. (*See* Declaration of Sarah Givan, Ex. 1; Declaration of
5 Myrna Hennessy, ¶¶ 6-8). SLB offers no evidence of out-of-state party witnesses who would be
6 required to travel, nor does SLB suggest that it would be easier to travel to Los Angeles rather
7 than San Francisco. However, whether the matter is pending in Los Angeles or San Francisco,
8 out-of-state witnesses will be required to travel to California. Accordingly, the Court considers
9 this factor to be neutral.

10 **3. The Convenience of the Witnesses and Compulsory Process of Third Party**
11 **Witnesses.**

12 The convenience of the witnesses is often the most important factor when deciding a
13 motion to transfer, as is the availability of key witnesses not within compulsory process of a
14 district court is a factor. *See Gulf Oil Co.*, 330 U.S. 508-09. As stated previously, party
15 witnesses are located in both the Central and Northern Districts. As with party witnesses, SLB
16 has not identified with specificity any out-of-state third-party witnesses who would have
17 information material to Wham-O's claims. Wham-O advises the Court that third party
18 witnesses are located in Minnesota, Arkansas, Michigan and New Jersey. Because key
19 witnesses are located in both the Central and Northern Districts and because SLB has not shown
20 that it would be more convenient for out-of-state witnesses to travel to Los Angeles rather than
21 San Francisco, the Court finds these two factors to be neutral.

22 **4. The Ease of Access to Sources of Proof.**

23 Access to sources of proof is another factor to consider when evaluating a motion to
24 transfer. *Gulf Oil Co.*, 330 U.S. at 508. Again, SLB does not address this factor specifically but
25 its principal place of business is within the Central District. Therefore, it is likely that much of
26 SLB's evidence is located there. Similarly, Wham-O's principal place of business is within the
27 Northern District and therefore its evidence likely is located within this district. The Court finds
28 this factor to be neutral.

For the Northern District of California

For the Northern District of California

For the Northern District of California

For the Northern District of California

For the Northern District of California

For the Northern District of California

For the Northern District of California

For the Northern District of California

For the Northern District of California

For the Northern District of California

For the Northern District of California